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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,097	09/11/2003	Alan L. Kriz	DEKM:158ÜSC1	5213

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT PAPER NUMBER

1638

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/660,097	Applicant(s) KRIZ ET AL.	
	Examiner Cynthia Collins	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 64-70 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 64-70 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on September 11, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1003</u> . | 6) <input type="checkbox"/> Other: _____  |

*[Handwritten signature]*

## **DETAILED ACTION**

### ***Claim Objections***

Claim 69 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 67 is drawn to a fertile transgenic plant transformed with the isolated gamma coixin promoter of claim 64. Claim 69 is drawn to the fertile transgenic plant of claim 67 wherein the plant was transformed with "said isolated gamma coixin promoter"; "said isolated gamma coixin promoter" in claim 69 appears to refer to the isolated gamma coixin promoter of claim 64, and therefore does not further limit 67.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The abstract of the disclosure is objected to because it is not commensurate in scope with the claimed invention. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 101***

Claim 68 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 68 is drawn to progeny of any generation of a plant comprising the isolated gamma coixin promoter of claim 64, but is not limited to progeny that comprise the isolated gamma

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coixin promoter that was introduced into the parent plant. Due to Mendelian inheritance of genes, a single construct introduced into the parent plant would only be transferred to half of the progeny of that plant. In addition, given that there is no indication that there are any other distinguishable characteristics of the claimed progeny, the claimed progeny are not distinguishable from plants that occur in nature. See *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), *Funk Bros. Seed Co. V. Kalo Inoculant Co.*, 233 U.S. 127 (1948), and *In re Bergey*, 195 USPQ 344, (CCPA). The amendment of the claim to indicate that the progeny comprise the isolated gamma coixin promoter that was introduced into the parent plant would overcome the rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 64-70 are rejected under 35 U.S.C. 102(b) as being anticipated by de Freitas FA et al. (Structural characterization and promoter activity analysis of the gamma-kafirin gene from sorghum. *Mol Gen Genet.* 1994 Oct 28;245(2):177-86).

The claims are drawn to an isolated gamma coixin promoter wherein the promoter comprises a fragment of the nucleic acid sequence of SEQ ID NO:8 having promoter activity, and to said promoter further defined as operably linked to an exogenous gene that is operably linked to a terminator. The claims are also drawn to an expression vector comprising said

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promoter. The claims are additionally drawn to a fertile transgenic plant transformed with said promoter and to said plant further defined as a progeny plant of any generation of a plant comprising said isolated gamma coixin promoter.

de Freitas FA et al. teach an isolated gamma kafirin promoter wherein the promoter comprises a fragment of the nucleic acid sequence of SEQ ID NO:8 having promoter activity, and said promoter operably linked to an exogenous gene that is operably linked to a terminator, an expression vector comprising said promoter, and transgenic plant transformed with said promoter (pages 183-185; see also attached sequence alignment with de Freitas FA et al., GenBank Accession No. X62480, 13-FEB-1995, *S. vulgare* gene for gamma-kafirin). While de Freitas FA et al. do not teach that a gamma kafirin promoter is a gamma coixin promoter, de Freitas FA et al. need not teach this limitation in order to anticipate the rejected claims, because the name "gamma coixin" imparts no particular structural attributes to the claimed promoter polynucleotide, since the source of a polynucleotide does not distinguish its chemical composition. While de Freitas FA et al. are silent with respect to whether their transgenic plants are fertile, their transgenic plants are presumed to be fertile absent evidence to the contrary, since fertility is inherent to organisms that normally reproduce sexually. While de Freitas FA et al. do not teach transgenic progeny plants, de Freitas FA et al. need not teach this limitation in order to anticipate the rejected claims, because the method of manufacture of transgenic progeny plants does not distinguish them from their parental plants.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 64-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,635,806. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-15 of U.S. Patent No. 6,635,806 are directed to an isolated gamma coixin promoter wherein the promoter comprises the nucleic acid sequence of SEQ ID NO:8, and to isolated gamma coixin promoters comprising specific subsequences of SEQ ID NO:8, whereas claims 64 to 70 of the instant application are directed to an isolated gamma coixin promoter wherein the promoter comprises the nucleic acid sequence of SEQ ID NO:8, and to isolated gamma coixin promoters comprising unspecified subsequences of SEQ ID NO:8.

#### ***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins  
Primary Examiner  
Art Unit 1638

CC

  
9/29/05